

35 U.S.C. §§ 102(e) and 374

as amended by

H.R. 2215 (Technical Amendment Act)

Date enacted: 11/02/02

Date effective: 11/29/00

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Overview – Major changes to 35 USC §§ 102(e) and 374, by enactment of HR 2215

35 USC § 102(e), after enactment of HR 2215, completely replaces § 102(e) as set forth in the AIPA and is retroactively effective to the date of the AIPA (11/29/00).

35 USC § 102(e), after enactment of HR 2215, is however similar to the pre-AIPA § 102(e), with 2 significant differences, which may be summarized as:

- ✓ In addition to U.S. patents, now certain **publications** of U.S. and international (PCT) applications (IAs) may qualify as prior art references under 35 USC § 102(e)
- ✓ **Certain international filing dates** are now considered to be U.S. filing dates under 35 USC § 102(e) and may now be used as the prior art date of a reference to make rejections, under 35 USC §§ 102(e) and 103(a).

Overview – Major changes to

35 USC §§ 102(e) and 374, by enactment of HR 2215 (Cont'd)

Prior art references now available under § 102(e)

1. U.S. Patents (formerly: could not use any IA filing date)

Now: If a U.S. patent issues from, or claims benefit of, an IA, the U.S. patent's prior art date may now be the filing date of the IA if the following three conditions are met:

- 1) the IA was filed on or after 11/29/00;
- 2) the IA designated the US; and
- 3) the IA publication (by WIPO) was in **English**.

Note: when the three conditions are met, the IA filing date is a U.S. filing date for § 102(e) purposes.

2. U.S. Application Publications (did not exist before 11/29/00):

Now: A U.S. application publication is prior art as of the application's U.S. effective filing date, which can include an IA filing date, if the same three conditions are met.

Overview – Major changes to

35 USC §§ 102(e) and 374, by enactment of HR 2215 (Cont'd)

Prior art references now available under § 102(e) (Cont'd)

3. WIPO Publications of IAs
(formerly: A WIPO publication
was not prior art under § 102(e))

Now: A WIPO publication of an
IA is § 102(e)(1) prior art as of
the IA's filing date, if the same
three conditions are met; namely:

- 1) the IA was filed on or after
11/29/00,
- 2) the IA designated the US, &
- 3) the IA publication (by WIPO)
was in English.



(10) International Publication Number
WO 02/44176 A1

PCT

(21) International Application Number: PCT/DK01/00791

(22) International Filing Date:

28 November 2001 (28.11.2001)

(25) Filing Language:

English

(26) Publication Language:

English

(81) Designated States (national): AE, AG, AL, AM, AT, AU, AZ, BA, BB, BG, BR, BY, BZ, CA, CH, CN, CO, CR, CU, CZ, DE, DK, DM, DZ, EC, EE, ES, FI, GB, GD, GE, GH, GM, HR, HU, ID, IL, IN, IS, JP, KE, KG, KP, KR, KZ, LC, LK, LR, LS, LT, LU, LV, MA, MD, MG, MK, MN, MW, MX, MZ, NO, NZ, PH, PL, PT, RO, RU, SD, SE, SG, SI, SK, SL, TJ, TM, TR, TT, TZ, UA, UG, US, UZ, VN, YU, ZA, ZW.

Sample WIPO Publication

Overview – When to use the new and old 35 USC § 102(e) provisions

NEW: The new 35 USC § 102(e) provisions must be used in examining **any** application, or patent under reexamination, effective immediately,

with one exception, when the old (pre-AIPA) §102(e) provisions must be used. See below.

OLD: The old (pre-AIPA) 35 USC § 102(e) provisions are **only** used when a prior art reference is a patent issued (directly or indirectly) from an IA which was filed before 11/29/00.

In this situation, the prior art date of such patent under the pre-AIPA 35 USC § 102(e) should be used. This would usually be the 35 USC § 371 (c)(1),(2) and (4) date of fulfillment

**35 USC §§ 102(e) & 374 after HR 2215
Previously Published § 102(e) Guidelines and Materials are Obsolete**

ALL previous guidance and implementation materials on the AIPA's § 102(e) are outdated. Thus, the following are out of date and should no longer be relied upon:

- ✓ *Examination Guidelines for 35 USC 102(e)(2), as amended by the AIPA of 1999, 1243 OG 1037 (Feb. 27, 2001)*
- ✓ Guidelines for applying references under § 102(e) set forth in the 8th edition of the MPEP (August 2001)
- ✓ Previous training materials on 35 USC §§ 102(e) and 374 after the AIPA (dated prior to 10/01/02)
- ✓ Q's and A's on the USPTO's website addressing 35 USC §§ 102(e) and 374 after the AIPA posted prior to 10/01/02
- ✓ Form paragraphs and examination notes for using those form paragraphs, prior to 10/01/02

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35 USC §102(e) AFTER H.R. 2215¹

“A person shall be entitled to a patent unless —

* * * *

(e) the invention was described in

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent,

except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or” (emphasis added)

¹**Caveat:** The relevant effective date provision of HR 2215 requires that the old (Pre-AIPA) §102(e) applies when the prior art reference is a patent issued (directly or indirectly) from an IA which was filed before 11/29/00.

35 USC § 374 after H.R. 2215

“The publication under the treaty defined in section 351(a) of this title, of an international application designating the United States shall be deemed a publication under section 122(b), except as provided in sections 102(e) and 154(d) of this title.”

This provision allows certain WIPO publications of IAs to be used as prior art under 35 USC § 102(e) as of the IA's filing date, if the previously set forth three conditions are met, namely:

- 1) the IA was filed on or after 11/29/00;
- 2) the IA designated the US; and
- 3) the IA publication (by WIPO) was in English.

H.R. 2215 Statutory Changes to the effective date provisions

EFFECTIVE DATE PROVISIONS (section 4508 of AIPA as revised by HR 2215).

* * * * *

Except as otherwise provided in this section, the amendments made by section 4505* shall be effective as of November 29, 2000 and shall apply to all patents and all applications for patents pending on or filed after November 29, 2000. (emphasis added)

This provides for uniform application of §102(e) to reject claims in any applications under examination, or any patents under reexamination or being contested, regardless of filing date.

* Section 4505 of the AIPA set forth the revision to § 102(e)

H.R. 2215 Statutory Changes to the effective date provisions *continued*

EFFECTIVE DATE PROVISIONS (section 4508 of ALPA as revised by HR 2215).

* * * * *

Patents resulting from an international application filed before November 29, 2000 and applications published pursuant to section 122(b) or Article 21(2) of the treaty defined in section 351(a) resulting from an international application filed before November 29, 2000 shall not be effective as prior art as of the filing date of the international application; however, such patents shall be effective as prior art in accordance with section 102(e) in effect on November 28, 2000. (emphasis added)

This provides that: 1) patents and application publication references may not rely on an I/A filing date for § 102(e) purposes if that date is before 11/29/00, nor may such international application be used as a bridge to an earlier U.S. filing date for prior art purposes, and
2) 35 USC § 371 date is used for patents of IAs filed prior to 11/29/00.

Applying 35 USC § 102(e): U.S. Publications & Patents from § 111(a) applications (Guideline 1 of 5)

Guideline 1: If U.S. patent or U.S. application publication issued from an application under 35 USC § 111(a), and the patent or application does not claim a benefit of an IA, the patent or application publication has a § 102(e) prior art date as of the earliest U.S. effective filing date.

See examples A1A (supra) and A1B, P1 (appendix).

✓ Effective filing date is the filing date for which priority/benefit is claimed under 35 USC §§ 119(e) & 120 so long as subject matter used to make the rejection is appropriately supported in the earlier filed application's disclosure (and any intermediate application(s)).

✓ Types of Priority & Benefit Claims

- 1) Priority to prior U.S. provisional application(s) (35 USC § 119(e))
- 2) Benefit of prior U.S. nonprovisional application(s) (35 USC § 120)

Note: The prior art date for more than 80% of the references that can be applied under 35 USC § 102(e) can be determined under this guideline.

Ex. A1A. PUBLICATION OF § 111(a) APPLICATION WITH § 119(e) PRIORITY CLAIM TO A PROVISIONAL APPLICATION.

Sample Application Publication – Guideline 1

United States

Patent Application Publication

Pub. No.: US 2002/0030988 A1
Pub. Date: Mar. 14, 2002

Filed:

Jul. 12, 2001

§ 111(a) application
filing date

Related U.S. Application Data

**Non-provisional of provisional application No.
60/218,706, filed on Jul. 17, 2000.**

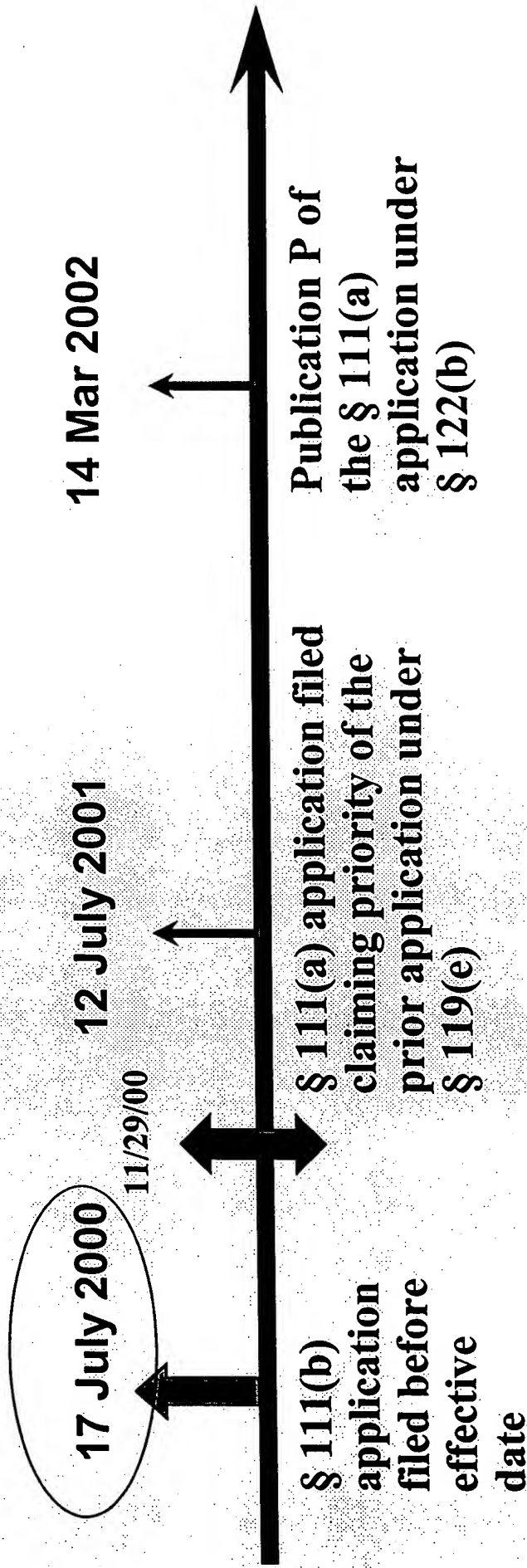
§ 111(b) application filing date

Guideline 1. If U.S. patent or application publication issued from an application under 35 USC § 111(a), and the application does not claim a benefit of an IA, the patent or application publication has a § 102(e) prior art date as of the earliest U.S. effective filing date.

U.S. application publication § 102(e)(1) date: 17 July 2000

Ex. A1A. PUBLICATION OF § 111(a) APPLICATION WITH § 119(e) PRIORITY CLAIM TO A PROVISIONAL APPLICATION.

Sample Timeline – Guideline 1



U.S. application publication § 102(e)(1) date: 17 July 2000

§ 102(e) Prior Art Date for Publication and Patent based (directly or indirectly) on an IA

The international filing date of an IA is a critical threshold condition in determining the effective prior art date of an application **publication** and **patent**

The critical inquiry is:

Does the IA have an international filing date on or after 11/29/00 (Guidelines 2 and 3),
or

Does the IA have an international filing date prior to 11/29/00 (Guidelines 4 and 5).

Note: For information on obtaining WIPO documents to determine the IA filing date, whether the US was designated and publication language see slides 45-51 in the Appendix.

Determining § 102(e) Prior Art Dates **Publications and Patents Involving IAs (Guideline 2 of 5)**

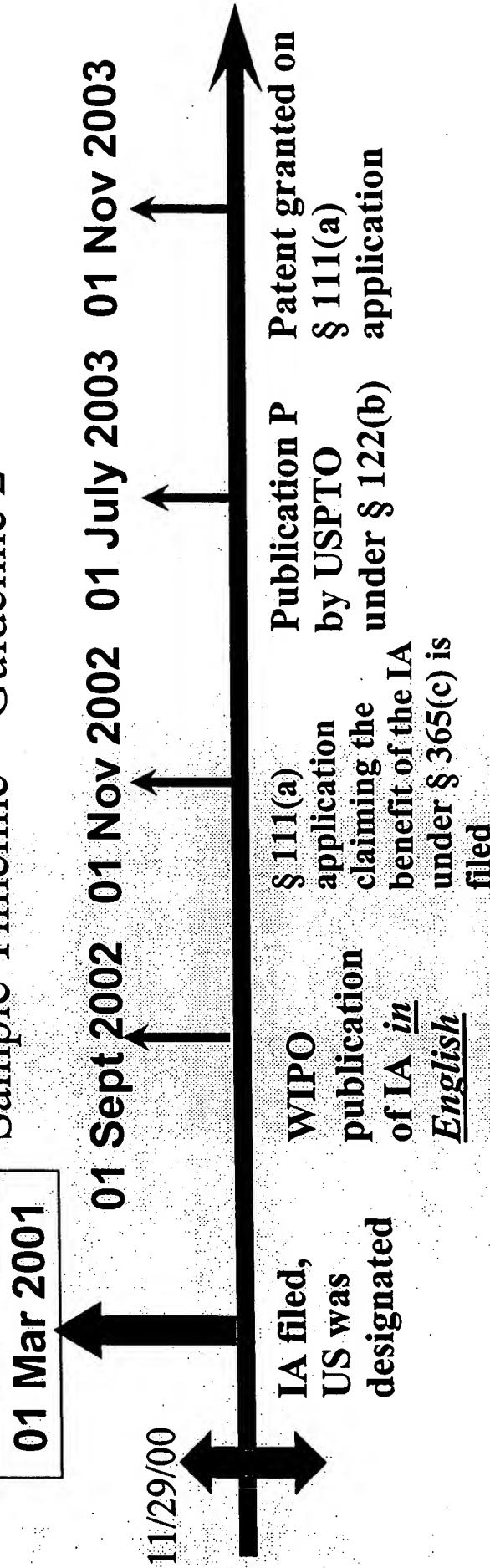
Guideline 2: If the U.S. patent, U.S. application publication, or WIPO publication issued from, or claims benefit to, an IA which has an international filing date on or after 11/29/00, designated the United States, and was published in English by WIPO (under PCT Article 21(2)) the **§ 102(e) date is the international filing date, or any earlier effective U.S. filing date.**
See examples P2A and P2B (supra) and A2A – A2C and P2C (appendix).

NOTES:

- 1) If the conditions above are met, the IA filing date is a U.S. filing date for prior art purposes.
- 2) The effective U.S. filing date is affected by priority/benefit claims under 35 USC §§ 119(e), 120 & 365(c). Note: Any IA having a filing date relied upon under 365(c) (continuity benefit claim) must satisfy the three conditions above if the relied upon IA filing date(s) is to be considered a U.S. filing date for prior art purposes.
- 3) A claim under §365(a) is a foreign priority claim to an IA and will not result in an earlier U.S. filing date (and IA filing date cannot be used as a prior art date).

**Ex. P2A: PATENT DERIVED FROM § 111(a) CONTINUATION OF AN IA
FILED ON/AFTER 11/29/00**

Sample Timeline – Guideline 2



Guideline 2. If the U.S. patent, U.S. application publication, or WIPO publication issued from, or claims benefit to, an IA which has an international filing date on or after 11/29/00, designated the United States, and was published in English by WIPO (under PCT Article 21(2)) the § 102(e) date is the international filing date, or any earlier effective U.S. filing date.

§ 102(e)(2) date of the patent: 01 Mar 2001

- Notes:
- 1) The § 102(e)(1) date of U.S. application publication P is 01 Mar 2001.
 - 2) The § 102(e)(1) date of the WIPO publication is 01 Mar 2001
 - 3) Prior to the AIPA, the § 102(e) date would have been 01 Nov 2002 (patent only).

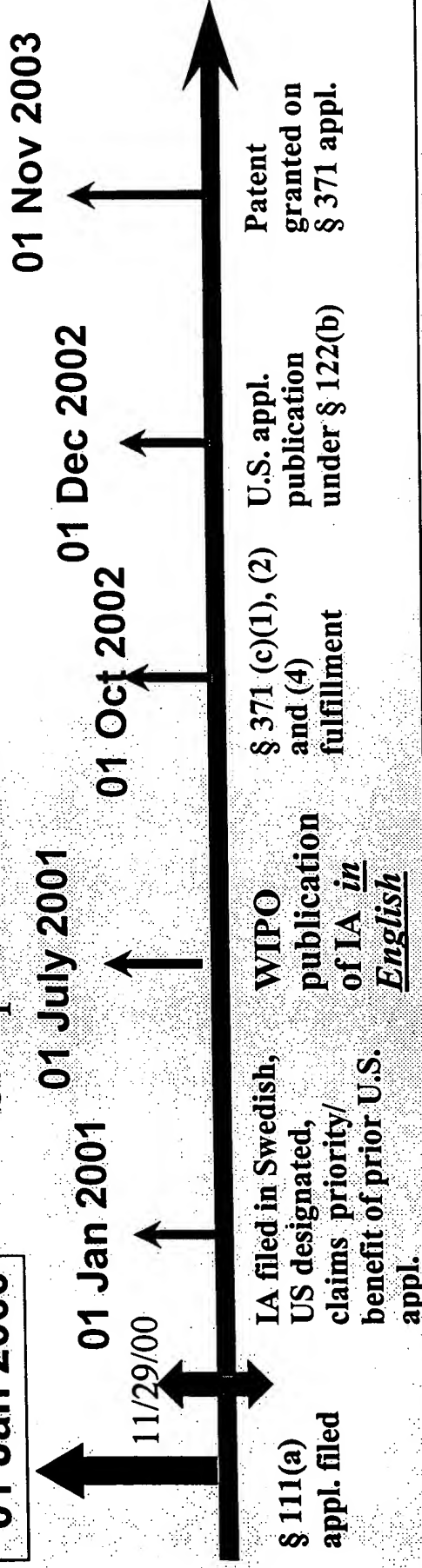
November 14, 2002

§ 102(e) after HR 2215

**Ex. P2B: PATENT DERIVED FROM THE NATIONAL STAGE OF IA
(§ 371 APPLICATION) WHICH CLAIMS PRIORITY/BENEFIT OF A U.S.
APPLICATION – (IA FILED ON/AFTER 11/29/00)**

Sample Timeline – Guideline 2

01 Jan 2000



Guideline 2. If the U.S. patent, U.S. application publication, or WIPO publication issued from, or claims benefit to, an IA which has an international filing date on or after 11/29/00, designated the United States, and was published in English by WIPO (under PCT Article 21(2)) the § 102(e) date is the international filing date, or any earlier effective U.S. filing date.

§ 102(e)(2) date of the patent: 01 Jan 2000

Notes: (1) § 102(e)(1) date of the WIPO publication is 01 Jan 2000

(2) § 102(e)(1) date of U.S. application publication is 01 Jan 2000

(3) Prior to the AIPA, the § 102(e) date of the patent would have been 01 Oct 2002

(4) Creates new prior art date before effective date of the change based on post 11/29/00 international filing date.

**Applying 35 USC § 102(e):
U.S. Patents of IAs (Guideline 3 of 5)**

Guideline 3. If the U.S. patent issued from, or claims benefit to, an IA which was filed on or after 11/29/00, but the WIPO publication was not in English, the U.S. patent:

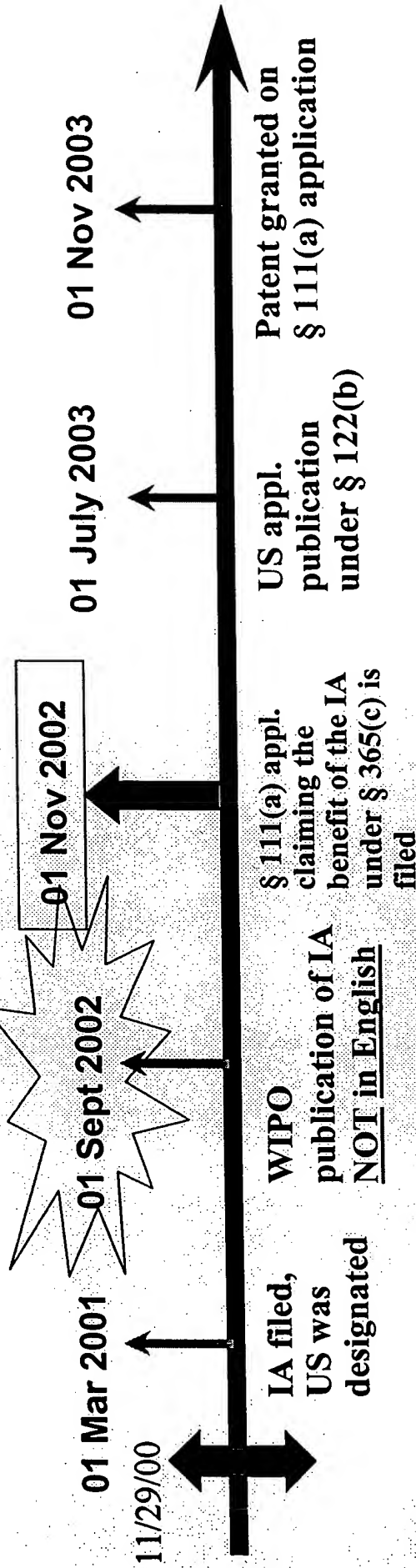
if issued from the 35 USC § 371 application, has **no § 102(e)(2) date**, or

if issued from a U.S. continuing application claiming benefit of the IA, has for its § 102(e)(2) date the filing date of a later-filed continuing U.S. application

See examples P3A and P3B (supra) and P3C (appendix).


Ex. P3A: PATENT DERIVED FROM § 111(a) CONTINUATION OF AN IA FILED ON/AFTER 11/29/00, WIPO PUBLICATION NOT IN ENGLISH

Sample Timeline – Guideline 3



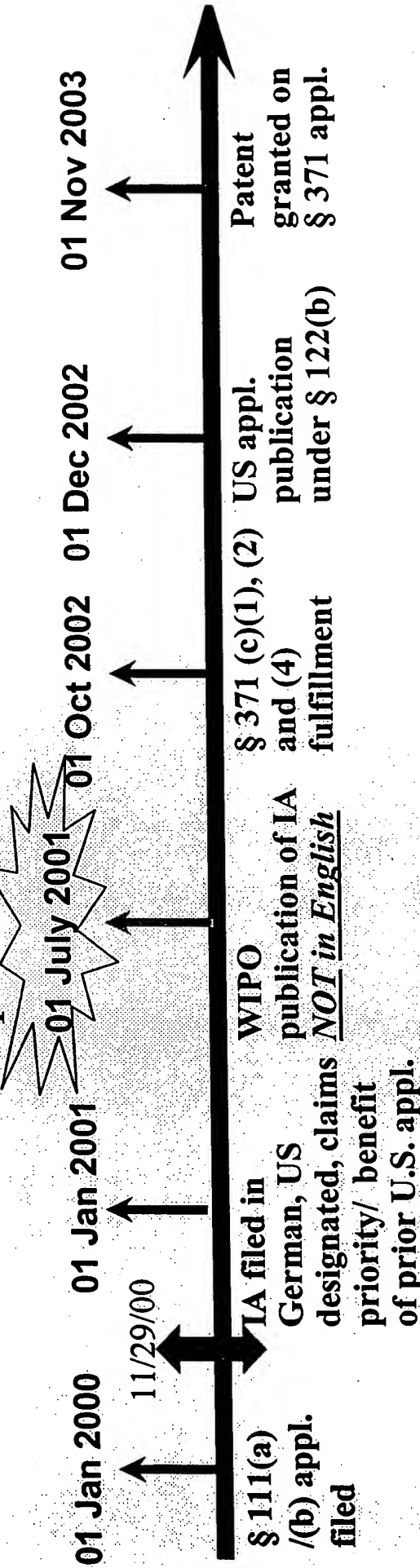
Guideline 3. If the U.S. patent issued from, or claims benefit to, an IA which was filed on or after 11/29/00, but the WIPO publication was not in English, the U.S. patent: if issued from the 35 USC § 371 application, has no § 102(e)(2) date, or if issued from a U.S. continuing application claiming benefit of the IA, has for its § 102(e)(2) date the filing date of a later-filed continuing U.S. application

§ 102(e)(2) date of the patent: 01 Nov 2002

- Notes: 1) The WIPO publication does NOT have a § 102(e)(1) date because the IA was not published in English.
- 2) § 102(e)(1) date of the U.S. appl. publication: 01 Nov 2002.
- 3) The best prior art date for the disclosure is the § 102(a) or (b) date ~~(01 Sept 2002)~~  01 Sept 2002.
- of the IA publication by WIPO.
- 4) Prior to the AIPA, the § 102(e) date would have been the same 01 Nov 2002.

Ex. P3B: PATENT DERIVED FROM THE NS OF AN IA (§ 371 APPLICATION) WHICH CLAIMS PRIORITY/BENEFIT OF A U.S. APPLICATION (IA FILED ON/AFTER 11/29/00, WIPO PUBLICATION NOT IN ENGLISH)

Sample Timeline – Guideline 3



Guideline 3. If the U.S. patent issued from, or claims benefit to, an IA which was filed on or after 11/29/00, but the WIPO publication was not in English, the U.S. patent: if issued from the 35 USC § 371 application, has no § 102(e)(2) date, or if issued from a U.S. continuing application claiming benefit of the IA, has the § 102(e)(2) date of the filing date of a later-filed continuing U.S. application

§ 102(e)(2) date of the patent: NONE

Notes: 1) U.S. appl. publication and WIPO publication do NOT have a § 102(e)(1) date because the IA was not published in English.

2) The best prior art date for the disclosure is the § 102(a) or (b) date ~~01 July 2001~~ of the IA publication by WIPO.

3) Prior to the AIPA, the § 102(e) date of the patent would have been 01 Oct 2002.

**Applying 35 USC § 102(e):
U.S. and WIPO Publications of IAs (Guideline 4 of 5)**

Guideline 4. The publication of the IA (either a WIPO publication or a US publication of a NS application) is not considered prior art under § 102(e)(1) as of the IA filing date if any of the following conditions are true:

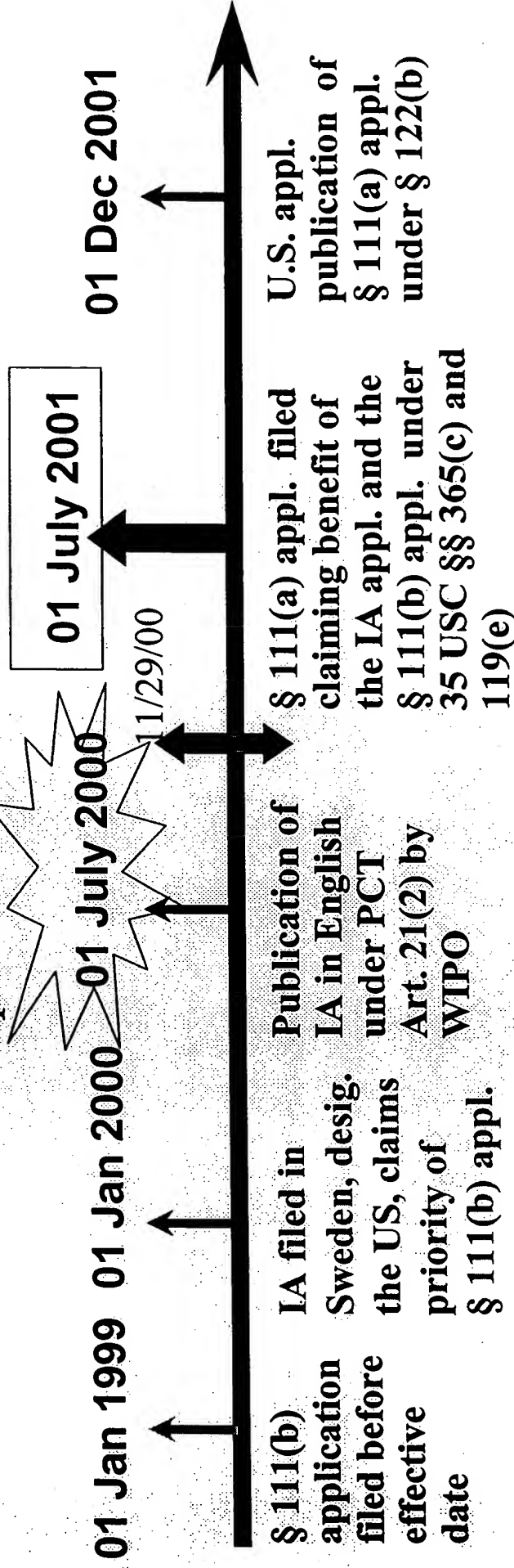
- 1) The international filing date was **prior** to 11/29/00,
- 2) The IA did not designate the U.S., or
- 3) The WIPO publication of the IA was **not** in English.

Since the IA filing date is not considered a U.S. filing date for prior art purposes, any earlier U.S. filing dates for which benefit is claimed by the IA are not § 102(e) prior art dates.
See Examples A4A through A4C (supra).

Note: The publication of such an IA is prior art under § 102(a) or § 102(b) as of its **publication date**.

Ex. A4A: PUBLICATION OF § 111(a) APPLICATION WHICH IS A CONTINUATION OF AN IA FILED BEFORE 11/29/00 AFTER PUBLICATION OF IA BY WIPO IN ENGLISH WHICH CLAIMS PRIORITY OF A PRIOR U.S. PROVISIONAL APPLICATION

Sample Timeline – Guideline 4



§ 102(e)(1) date of U.S. application publication : 01 Jul 2001

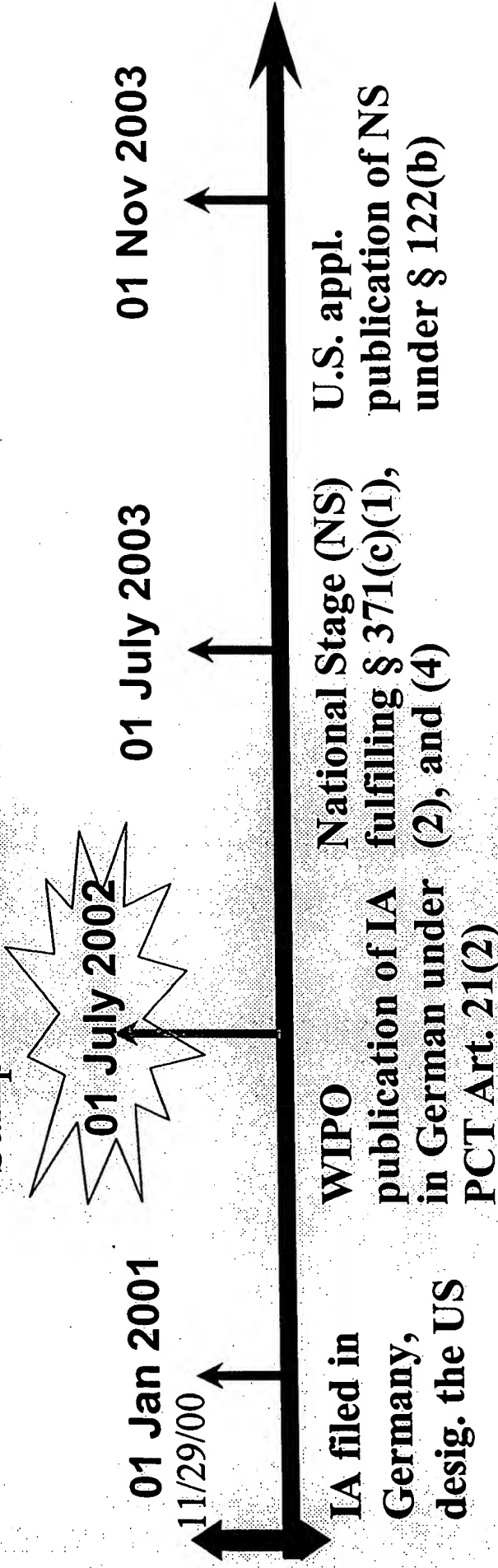
§ 102(e)(1) date of WIPO publication of IA (PCT): NONE
because the IA was filed prior to the effective date: Nov. 29, 2000

Note: The WIPO publication is available as prior art under § 102(a) or (b).

The best prior art date is the WIPO publication date: 01 Jul 2000.

Ex. A4B: PUBLICATION OF NATIONAL STAGE APPLICATION AFTER PUBLICATION OF IA FILED ON/AFTER 11/29/00 BY WIPO IN A LANGUAGE OTHER THAN ENGLISH

Sample Timeline – Guideline 4

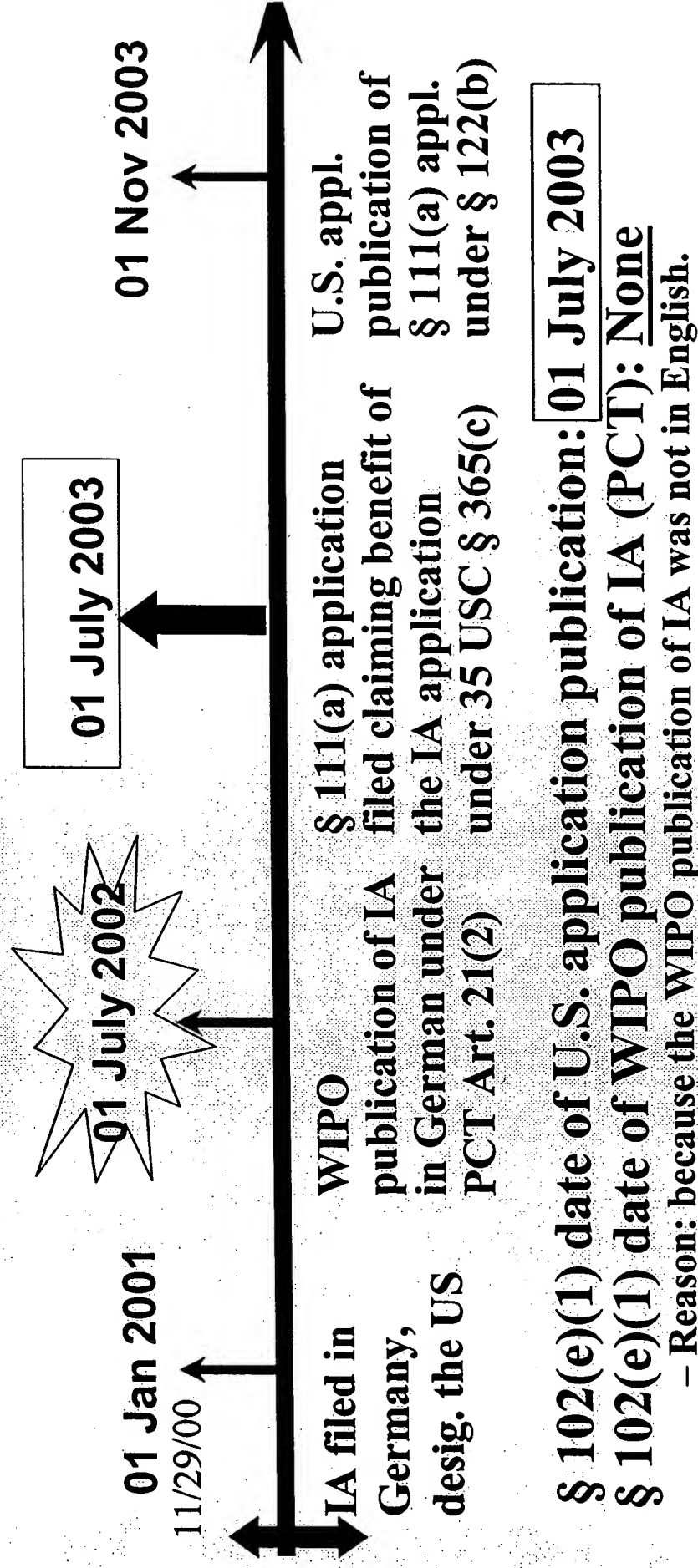


§ 102(e)(1) date of U.S. application publication: **NONE**
 § 102(e)(1) date of WIPO publication of IA (PCT): **NONE**
 Because the WIPO publication of the IA (PCT) was not in English.

Note: Both publications are available as prior art under § 102(a) or (b) as of their publication dates.

Ex. A4C: PUBLICATION OF § 111(a) APPLICATION WHICH IS A CONTINUATION OF AN IA FILED ON/AFTER 11/29/00 AFTER PUBLICATION OF IA BY WIPO IN A LANGUAGE OTHER THAN ENGLISH

Sample Timeline – Guideline 4



**Note: The WIPO publication is available as prior art under § 102(a) or (b).
The best prior art date is the WIPO publication date: ~~01 Jul 2002.~~**

Determining § 102(e) Prior Art Dates Patents involving IAs (Guideline 5 of 5)

Guideline 5: If the U.S. patent issued from, or claims benefit to, an IA filed **prior** to Nov. 29, 2000, the date of such a prior art patent is the earlier of the date of compliance with § 371(c)(1), (2) and (4) (e.g. National Stage entry) or the filing date of a later-filed U.S. application that claimed the benefit of the international application. See § 102(e) prior to AIPA (next slide) & § 4508 of AIPA (slide 11). See examples P5A through P5C (supra) and P5D (appendix).

Determining § 102(e) Prior Art Dates

Patents involving IAs (Guideline 5 of 5).

35 USC § 102(e), prior to the AIPA

In effect prior to 11/29/00

“A person shall be entitled to a patent unless —

...

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by applicant for patent, or”

Ex. P5A: PATENT DERIVED FROM THE NATIONAL STAGE OF AN IA WHICH CLAIMS PRIORITY OF A U.S. PROVISIONAL APPLICATION

Sample Patent – Guideline 5

United States Patent

Patent No.: US 6,355,606 B1

(22) PCT Filed: Jul. 8, 1998

Date of Patent:

Mar. 12, 2002

(86) PCT No.: PCT/US98/14056

IA filing date

§ 371 Date: Jan. 14, 2000

Fulfillment of § 371 (c)(1)(2) &

§ 102(e) Date: Jan. 14, 2000

(4)

(87) PCT Pub. No.: WO99/03964

PCT Pub. Date: Jan. 28, 1999

IA Publication by WIPO

Related U.S. Application Data

(60) Provisional application No. 60/052,464, filed on Jul. 14, 1997.

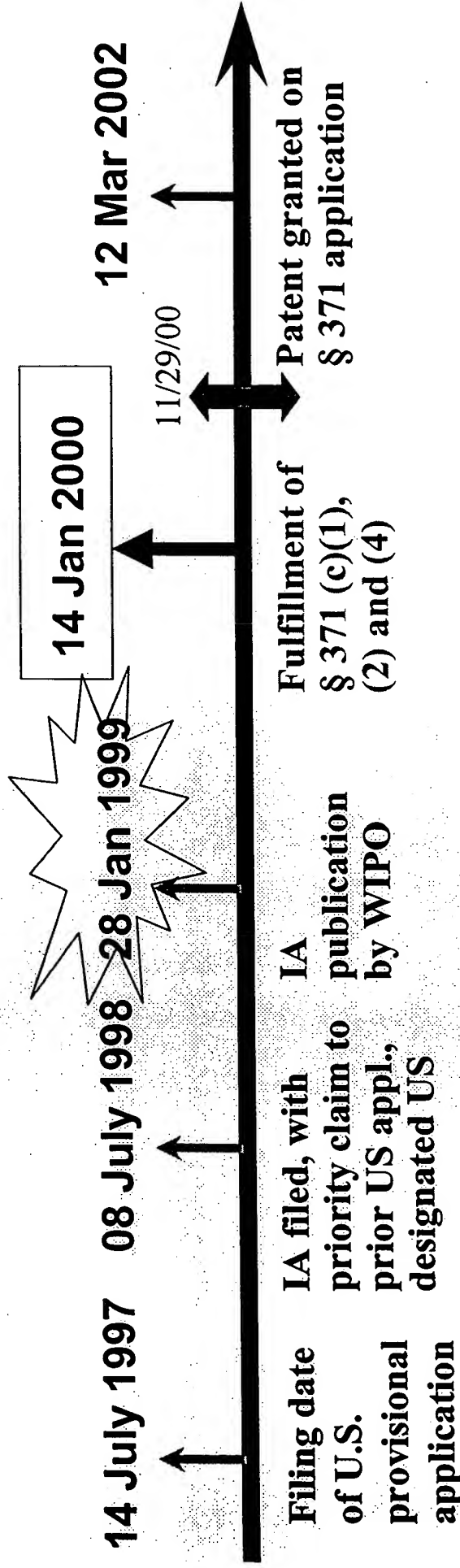
§ 111(b) application filed

§ 102(e) date of the patent: 14 Jan 2000

If the U.S. patent issued from, or claims benefit to, an IA filed prior to Nov. 29, 2000, the date of such a prior art patent is the earlier of the date of compliance with § 371(c)(1), (2) and (4) (e.g. National Stage entry) or the filing date of the later-filed U.S. application that claimed the benefit of the international application.

Ex. P5A: PATENT DERIVED FROM THE NATIONAL STAGE OF AN IA WHICH CLAIMS PRIORITY OF A U.S. PROVISIONAL APPLICATION

Sample Timeline – Guideline 5



§ 102(e) date of the patent: 14 Jan 2000

Reason: based on former (Pre-AIPA) provisions of § 102(e)

Notes:

- 1) Patent cannot be applied as of the earlier filing date of the provisional application for prior art purposes.
- 2) Best prior art date - IA publication date under § 102(a) or (b): 28 Jan 1999.

Ex. P5B: PATENT DERIVED FROM THE CONTINUATION OF AN IA WHICH CLAIMS PRIORITY/BENEFIT OF A U.S. APPLICATION

Sample Patent – Guideline 5

United States Patent

Patent No.: US 6,335,312 B1
Date of Patent: Jan. 1, 2002

§ 111(a) application filing date

Filed: **Apr. 4, 2000**

Related U.S. Application Data

IA filing date

Continuation of application No. PCT/IB98/01585, filed on **Oct. 12, 1998.**

Provisional application No. 60/061,916, filed on Oct. 14, 1997.

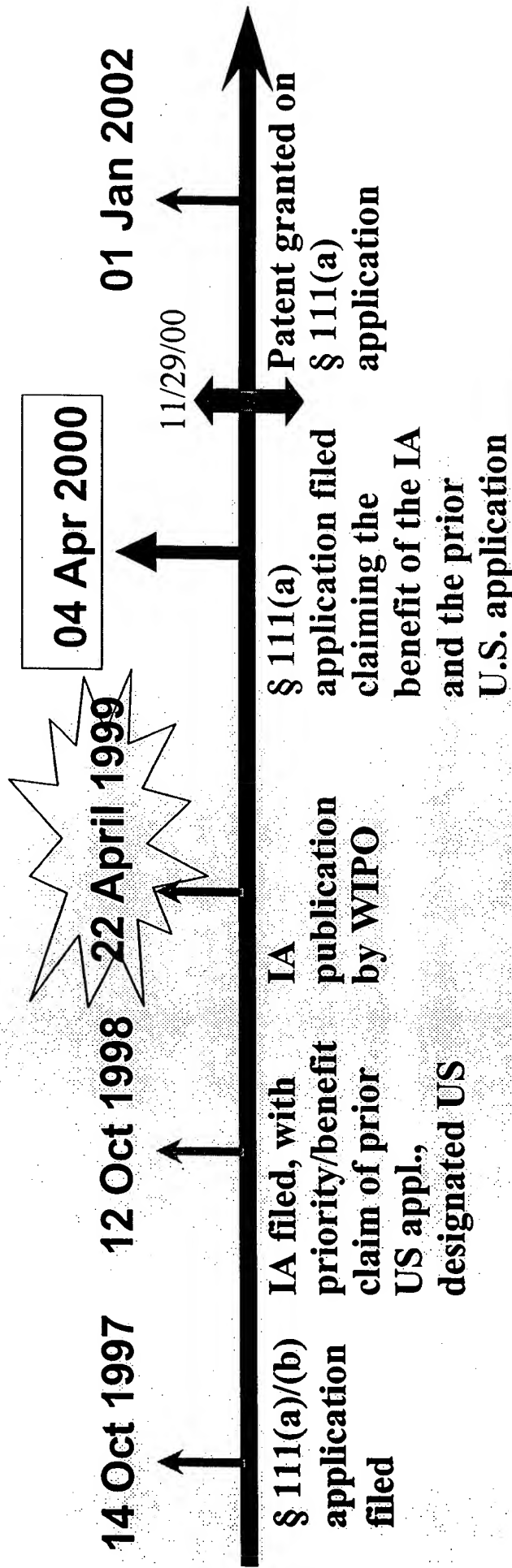
§ 111(b) application filing date

§ 102(e)(2) date of the patent : 04 Apr 2000

If the U.S. patent issued from, or claims benefit to, an IA filed prior to Nov. 29, 2000, the date of such a prior art patent is the earlier of the date of compliance with § 371(c)(1), (2) and (4) (e.g. National Stage entry) or the filing date of the later-filed U.S. application that claimed the benefit of the international application.

Ex. PSB: PATENT DERIVED FROM THE CONTINUATION OF AN IA WHICH CLAIMS PRIORITY / BENEFIT OF A U.S. APPLICATION

Sample Timeline – Guideline 5



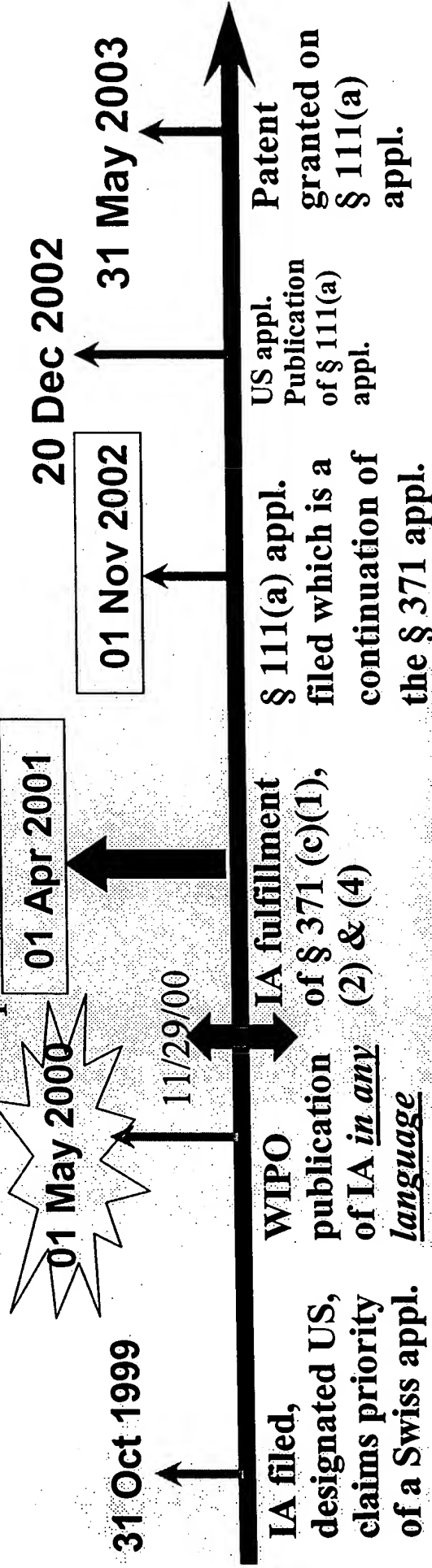
§ 102(e)(2) date of the patent: 04 Apr 2000

Notes:

- 1) Patent cannot be applied as of the earlier filing date of the IA or the earlier filing date of the § 111(a)/(b) application.
- 2) The best prior art date for the disclosure is the § 102(a) or (b) date (22 April 1999) of the WIPO publication of IA. The publication date can be determined by doing a family data search on the prior applications.

Ex. P5C: PATENT DERIVED FROM § 111(a) CONTINUATION OF THE NATIONAL STAGE OF AN IA FILED BEFORE 11/29/00

Sample Timeline – Guideline 5



§ 102(e) date of the patent: 01 Apr 2001 *(relies on the pre-AIPA §102(e) in order to be applied as prior art on the § 371 date)*

§ 102(e)(1) date of the U.S. application publication: 01 Nov 2002
(publication cannot be applied as a reference under § 102(e) using the IA filing date since the IA filing date is prior to 11/29/00. 35 USC § 371 date can never be used under § 102(e) for application publications.)

Notes: 1) The WIPO publication does NOT have a § 102(e)(1) date because the IA was filed prior to Nov. 29, 2000. 2) The best prior art date for the disclosure is the § 102(a) or (b) date (01 May 2000) of the WIPO publication of IA
November 14, 2002 § 102(e) after HR 2215

Summary

Determining § 102(e) Prior Art Dates for Publications and Patents involving IAs

IF IA has an international filing date on or after 11/29/00, the additional criteria that must exist in order to use the IA filing date as a prior art date under § 102(e) are:

- ✓ **The IA must have designated the U.S.**
- ✓ **IA must have been published in English by WIPO**

If both conditions are present, the international filing date can be used as a prior art date and it is a U.S. filing date for purposes of § 102(e).

If either condition is missing, the international filing date cannot be used as a prior art date. Further, since the IA filing date is **not** considered a U.S. filing date for prior art purposes, earlier U.S. filing dates for which benefit is claimed by the IA are not prior art dates.

Summary

Determining § 102(e) Prior Art Dates for Publications and Patents involving IAs - continued

IF IA has an international filing date prior to 11/29/00:

- For WIPO or U.S. application publications, NEVER apply a reference under § 102(e)(1) using the IA filing date or a U.S. filing date prior to the IA filing date. See Example A4A (Guideline 4).
- For patents, the § 102(e) date of such a prior art patent is the earlier of the date of compliance with § 371(c)(1), (2) and (4) (e.g., National Stage entry) or the filing date of the later-filed U.S. application that claimed the benefit of the international application. See Examples P5A through P5D (Guideline 5).

Implementation of § 102(e) in view of HR 2215

Previous prior art rejection(s) made using AIPA's § 102(e) where a reply by applicant(s) has been filed:

➤ Examiners should determine if reference(s) is still good prior art under § 102(e) in view of new law.

✓ In particular, examiners should pay special attention to U.S. application publications (applied against the claims) using international filing dates prior to 11/29/00 (or using such a date to complete a continuity claim). These references are no longer "prior" art under § 102(e) as amended by H.R. 2215.

✓ **Final rejection practice:** In the rare circumstance that a second or subsequent action contains a new ground of rejection necessitated by the change to § 102(e) that was not also necessitated by an amendment to the claims or as a result of certain information disclosure statements (See MPEP 706.02(a)), that action **cannot** be made final. See MPEP 706.07(a).

New prior art rejections using § 102(e) in view of new law.

➤ Examiners should immediately use revised (Oct. 2002 or later) § 102(e) form paragraphs (available from USPTO Home Page (intranet) under IT Announcements)

Implementation of § 102(e) in view of HR 2215 *continued*

Searching applications in view of § 102(e)

- The search conducted when examining all applications or patents under reexamination should include searching relevant patent application publications
- Updated searches for applications filed before 11/29/00 should include an appropriate search of patent application publications.
- WIPO publications of IAs may also be relevant to consider in view of § 102(e) but only if the IA filing date is on or after 11/29/00, the United States was designated and the IA was published in English under PCT Article 21(2) by WIPO.

Conclusion



DOs & DON'Ts of 35 USC § 102(e)

✓ **DO**

Apply § 102(e), as amended, to all applications under examination and patents under reexamination, **whenever filed**.

To determine the prior art date of a reference, use the flowcharts and follow the 5 guidelines for applying § 102(e).

✓

Consider proper domestic priority claims to provisional applications under § 119(e), benefit claims to nonprovisional applications under § 120 or benefit claims to international applications under § 365(c) in determining the effective U.S. filing date under 102(e), but remember the relied upon application and any intermediate application must support the subject matter used in the rejection.

✓ **DON'T**

EVER use an international filing date prior to 11/29/00 as a prior art date,

➤ a **patent** issuing from the National Stage of an IA filed before 11/29/00 will continue to be applied as of the § 371(c)(1), (2) and (4) date.

✓ **NO**

EVER apply a reference based on a foreign priority filing date claimed under 35 USC §§ 119(a)-(d) or 365(a), in U.S. or WIPO application publications or U.S. patents as the prior art date under § 102(e).

✓ EVER apply a reference based on the filing date of an IA when the IA did not designate the U.S. or was published in a language other than English. Use published IA as the reference, but under § 102(a) or (b) as of the publication date of the IA.

Information Contacts

For additional information visit the “35 USC §102(e) after HR 2215” website at:

<http://www.uspto.gov/web/offices/dcom/olia/aipa/whatsnew.htm>

Direct questions by e-mail or telephone to:

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Director of OPLA:

Robert J. Spar, at Bob.Spar@USPTO.gov or (703) 308-5107

Glossary of Terms

HR 2215 - Intellectual Property and High Technology Technical Amendments Act of 2002 (Pub. L. 107-273 (2002)).

AIPA = American Inventors Protection Act of 1999 (Pub. L. 106-113, 113 Stat. 1501 (enacted 11/29/1999))

§ 111(a) application = non provisional application filed under 35 USC § 111(a)

§ 111(b) application = provisional application filed under 35 USC § 111(b)

§ 119(e) = domestic priority claim relying on a provisional application

§ 120 benefit claim = a benefit claim made to an earlier non-provisional application.

Domestic priority/benefit claims under 35 USC §§ 119(e) and 120 = all references to claims for priority/benefit under §§ 119(e) & 120, respectfully. It will be assumed for the examples that the subject matter relied upon in making a rejection is supported in all of the parent applications relied upon by the application published or patented in the examples.

11/29/00 = effective date of AIPA amendments and HR 2215 amendments to

§§ 102(e) and 374

IA = international application

IA filed on/after 11/29/00 = international filing date is on or after 11/29/00

WIPO = World Intellectual Property Organization

PCT = Patent Cooperation Treaty

WIPO Publications = publications of IAs under PCT Article 21(2)

NS = National Stage of an international application (35 USC § 371 application)

Thank You

APPENDIX: Background

AIPA & H.R. 2215 (Technical Correction to AIPA)

On 11/29/00, the American Inventors Protection Act of 1999 (AIPA) provided 35 USC §102(e) prior art effect of:

- ✓ U.S. patent application publications;
- ✓ WIPO publications of international applications; and
- ✓ Patents (based on an IA filed on or after 11/29/00)

On 11/02/02, the Technical Correction Act (H.R. 2215) modified 35 USC § 102(e) under AIPA to make §102(e) applicable to all applications being examined, or patents under reexamination or being contested, whenever filed.

- ✓ §102(e) under H.R. 2215 is retroactive to 11/29/00.

APPENDIX: Caveats to consider when relying on priority dates of references

1. Disclosure support: Examiners should apply a reference as of an earlier effective filing date based on priority/benefit claims under 35 USC §§ 119(e), 120 & 365(c), if the subject matter relied upon in making a rejection is adequately supported (i.e. §112, 1st ¶) in all of the parent applications relied upon.
2. Priority/benefit claims: The priority/benefit data in U.S. application publications may not be accurate or complete since applications are generally published, as filed, without Office review or verification of priority/benefit claims.
 - ✓ Examiners should be aware that the priority/benefit claim on the front cover of the publication may be more inclusive than the claim made in the first sentence of the specification of the publication since the priority/benefit claim on the front cover is created from PALM data which is separately captured and updated.
 - ✓ Priority/benefit data in patents is more reliable than in publications.

APPENDIX: Caveats to consider when relying on priority dates of references

3. New Matter: Application publications, if published as a result of a request for amended publication, may include new matter. Any new subject matter in a publication may not be used in making a prior art rejection based on § 102(e) since such subject matter cannot receive the benefit of the application filing date.
4. Resolving Items 1, 2, & 3: Uncertainties about 1) sufficiency of the disclosure, 2) priority/benefit claims, and 3) new matter in application publications can be resolved by ordering and reviewing the file of the prior application(s) or patent(s).
5. Same application – publication and patent disclosures differ: A redacted application publication and the patent derived from the same application may be different. For example, the patent may contain additional disclosure (e.g. best mode) which is not contained in the application publication.

APPENDIX: Comparison Chart of Prior Art References: Pre-AIPA § 102(e) vs. Current (Post-AIPA § 102(e))

Type of Reference	Pre- AIPA § 102(e) Prior Art Dates	Current § 102(e) Prior Art Dates
U.S. publication of § 111(a) application	None – Did not exist	effective filing date (including any Int'l filing date claimed under 365(c) if on/after 11/29/00)*
U.S. publication of § 371 application	None – Did not exist	(1) Int'l filing date* (or any earlier effective filing date) if IA filed on/after 11/29/00, or (2) none if IA filed before 11/29/00
WIPO publication of IA	None - publication existed but no provision in Pre-AIPA §102(e) to use as prior art	(1) Int'l filing date* (or any earlier effective filing date) if IA filed on/after 11/29/00, or (2) none if filed before 11/29/00
U.S. patent from § 111(a) application	effective U.S. filing date	effective filing date (including any Int'l filing date claimed under 365(c) if IA filed on/after 11/29/00)*
U.S. patent from § 371	§ 371(c)(1),(2)&(4) fulfillment date	(1) <u>Int'l filing date*</u> (or any earlier effective filing date) if IA filed on/after 11/29/00, or (2) § 371(c)(1), (2) and (4) date if IA filed before 11/29/00

* IA must designate the U.S. and be published in English under PCT Article 21(2)

APPENDIX: Finding WIPO publications and determining IA filing date, US designation and publication language

When a US patent or US application publication is based on an international application (PCT) filed on or after 11/29/00 but is not prior art under § 102(a)/(b), the examiner may apply the reference under § 102(e) after verifying that the IA designated the US and was published in English.

SIRA is currently developing a WIPO Application Look Up Tool which would allow examiners to search the PCT document by international application number or by WIPO publication number.

Until the WIPO Application Look Up Tool is available, an interim way to verify whether the international application was published in English and designated the US is to locate the WIPO publications (PCT) using the family data tool available in the Derwent Database of EAST.

APPENDIX: Finding WIPO publications and determining IA filing date, US designation and publication language (*continued*)

Additionally, the WIPO and EPO websites have tools available to locate the WIPO publications (PCT) to verify whether the international application was published in English and designated the US.

WIPO's PCT Database contains first page data (e.g., designations and language of publication).

The database currently contains data published since January 1, 1997. From the WIPO site: <http://ipdl.wipo.int/>

select "search IPDL" from Guest Access

select "PCT Electronic Gazette" [Guest Access]

From the EPO's website: <http://ep.espacenet.com>

select "Worldwide - 30 million documents"

If you select "The World Intellectual Property Org. (PCT)", access to only the latest 24 months data is provided.

APPENDIX: Finding WIPO publications and determining IA filing date, US designation and publication language (*continued*)

Guidelines for using Family Data to find WIPO publications in the Derwent Database of EAST:

A text search of the US patent (6442983.pn.) or US application publication No. (20020029970) in the Derwent database will usually locate the document*.

Once the document is located (in a text browser), Select Family Data from the main menu of the EAST Browser (Tools -> text viewer -> Family Data) or use the Family Data button on the Text Toolbar.



EAST will automatically retrieve any available family data in a new browser (similar to forward and backward citation searches).

The detail view will list the WO document if it is retrieved by EAST (see following examples).

* If the publication date of the patent or application publication is very recent in time the information may not be loaded into the Derwent database. If the WIPO document number is unavailable, an inventor search in the Derwent database (e.g., wachtfogel.in.) should be performed.

APPENDIX: Finding WIPO publications and determining IA filing date, US designation and publication language (*continued*)

United States Patent Application Publication

(10) Pub. No.: US 2002/0052584 A1
(43) Pub. Date: May 2, 2002

(21) Appl. No.: 10/026,710 — 102(e) date
(22) Filed: Dec. 27, 2001

Related U.S. Application Data

(63) Continuation of application No. PCT/SE00/01287,
filed on Jun. 19, 2000.

(30) Foreign Application Priority Data

Jun. 29, 1999 (SE) 9902448-1

Ex. 1: Finding PCT/SE00/01287 using BRS/EAST.

1. Using the Derwent database, text search and browse application publication No. (e.g., 20020052584). Select Family Data from the main menu of the EAST Browser (Tools -> text viewer -> Family Data).
2. EAST will automatically retrieve any available family data in a new browser (similar to forward and backward citation searches).
3. The detail view will list the WO document if it is retrieved by EAST (see next slide).

APPENDIX: Finding WIPO publications and determining IA filing date, US designation and publication language (continued)

Ex. 1 (cont.): Detail View in EAST showing

Refcase Explorer - FAMILY: (1) 2001-146940			
	U	1	Document ID
1	<input type="checkbox"/>	<input checked="" type="checkbox"/>	US 20020052584 A1
2	<input type="checkbox"/>	<input type="checkbox"/>	WO 200100129 A1
3	<input checked="" type="checkbox"/>	<input type="checkbox"/>	SE 9902448 A
4	<input checked="" type="checkbox"/>	<input type="checkbox"/>	AU 200060335 A
5	<input checked="" type="checkbox"/>	<input type="checkbox"/>	SE 514909 C2
6	<input checked="" type="checkbox"/>	<input type="checkbox"/>	EP 1194102 A1
			Issue Date
			20020502
			20010104
			20001230
			20010131
			20010514
			20020410

Best prior art date for this disclosure is the Swedish application's publication date: 30 Dec 2000 under § 102(a)/(b) date

US designated

IA filing date prior to 11/29/00



(10) International Publication Number
WO 01/00129 A1

(43) International Publication Date
4 January 2001 (04.01.2001)

PCT

(21) International Application Number: PCT/SE00/01287

(22) International Filing Date: 19 June 2000 (19.06.2000)

(25) Filing Language: English

(26) Publication Language: English

(30) Priority Data: 9902448-1 29 June 1999 (29.06.1999) SE

(81) Designated States (national): AE, AG, AL, AM, AT, AU, AZ, BA, BB, BG, BR, BY, CA, CH, CN, CR, CU, CZ, DE, DK, EE, ES, FI, FR, GB, GR, GU, HK, HU, ID, IL, IN, IS, JP, KE, KG, KP, KR, KZ, LC, LK, LR, LS, LT, LU, LV, MA, MD, MG, MK, MN, MW, MX, MY, NZ, NO, NZ, PL, PT, RO, RU, SD, SE, SG, SI, SK, SL, TJ, TM, TR, TT, TZ, UA, UG, US, UZ, VN, YU, ZA, ZW.

IA of U.S. application publication

APPENDIX: Finding WIPO publications and determining IA filing date, US designation and publication language *(continued)*

(19)

United States

(12)

Patent Application Publication

(10) Pub. No.: US 2002/0138831 A1

Wachtfogel et al.

(43) Pub. Date: Sep. 26, 2002

(21)

Appl No.: 09/914,747

(86) PCT No.: PCT/IL01/00035

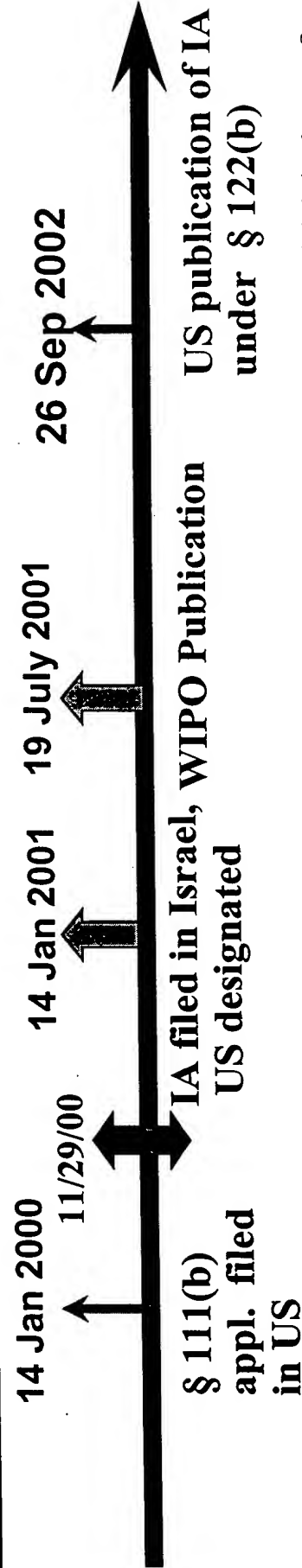
(22)

PCT Filed: Jan. 14, 2001

Related U.S. Application Data

(60)

Provisional application No. 60/176,215, filed on Jan. 14, 2000. Provisional application No. 60/179,968, filed on Feb. 3, 2000.




Ex. 2: If the PCT was published by WIPO in English (see next slide) the § 102(e)(1) date of the US application publication and the WIPO publication is 14 Jan 2000, assuming there is proper support for the claimed subject matter in the § 111(b) provisional appl.

APPENDIX: Finding WIPO publications and determining IA filing date, US designation and publication language (*continued*)

Ex. 2 (*cont.*): Because the US application publication is based on an international application (PCT) filed on or after 11/29/00, published in English and the IA designated the US, the examiner may apply the reference under § 102(e)(1) as of :

14 January 2000*

* assumes proper support for the claimed subject matter in the § 111(b) provisional application.

	(10) International Publication Number WO 01/52541 A1
	(43) International Publication Date 19 July 2001 (19.07.2001)
PCT	(21) International Application Number: PCT/TL01/00035
	(22) International Filing Date: 14 January 2001 (14.01.2001)
	(25) Filing Language: English
	(26) Publication Language: English
	(30) Priority Data: 60/176,215 14 January 2000 (14.01.2000) US 60/179,968 3 February 2000 (03.02.2000) US

APPENDIX: Applying § 102(e) Prior Art Date for Publications & Patents Five Guidelines (Positive 1, 2 & 3 and Negative 4 & 5)

1. If U.S. patent or U.S. application publication issued from an application under 35 USC § 111(a), and the patent or application does not claim a benefit of an IA, the patent or application publication has a § 102(e) prior art date as of the earliest U.S. effective filing date. See Examples A1A, A1B, P1.
2. If the U.S. patent, U.S. application publication, or WIPO publication issued from, or claims benefit to, an IA which has an international filing date on or after 11/29/00, designated the United States, and was published in English by WIPO (under PCT Article 21(2)) the **§ 102(e) date is the international filing date, or any earlier effective U.S. filing date.**

See examples A2A–A2C and P2A–P2C.

3. If the U.S. patent issued from, or claims benefit to, an IA which was filed on or after 11/29/00, but the WIPO publication was not in English, the U.S. patent: if issued from the 35 USC § 371 application, has **no § 102(e)(2) date**, or if issued from a U.S. continuing application claiming benefit of the IA, has the **§ 102(e)(2) date of the filing date of a later-filed continuing U.S. application**. See Examples P3A–P3C.

Applying 102(e) Prior Art Date for Publications & Patents

Five Guidelines continued

4. The publication of the IA (either a WIPO publication or a US publication of a NS application) is not considered prior art under § 102(e)(1) as of the IA filing date if any of the following conditions are true:

- 1) The international filing date was **prior** to 11/29/00,
- 2) The IA did not designate the U.S., or
- 3) The WIPO publication of the IA was **not** in English.

Since the IA filing date is not considered a U.S. filing date for prior art purposes, any earlier U.S. filing dates for which benefit is claimed by the IA are not prior art dates. See Examples A4A-A4C.

5. If the U.S. patent issued from, or claims benefit to, an IA filed **prior** to Nov. 29, 2000, the date of such a prior art patent is the earlier of the date of compliance with § 371(c)(1), (2) and (4) (e.g. National Stage entry) or the filing date of a later-filed U.S. application that claimed the benefit of the international application. See § 102(e) prior to AIPA (slide 27) & effective date provision (§ 4508) of AIPA (slide 11). See Examples P5A-P5C.

Appendix

Listing of All Examples

A1A, A1B*	U.S. or WIPO Publications applying § 102(e) using guideline 1.
P1*	U.S. Patent applying § 102(e) using guideline 1
A2A*-A2C*, P2A-P2C*...	U.S. or WIPO Publications and Patents applying § 102(e) using guideline 2.
P3A, P3B, P3C*	U.S. Patents applying § 102(e) using guideline 3.
A4A, A4B, A4C	U.S. or WIPO Publication applying § 102(e) using guideline 4.
P5A, P5B, P5C*	U.S. Patents following applying § 102(e) using guideline 5.

Representative CODE Definitions

A1A =	application publication, guideline 1, example 1
A3D =	application publication, guideline 3, example 4
P5B =	patent, guideline 5, example 2

* example is provided in the Appendix

EX. A1B. PUBLICATION OF § 111(a) APPLICATION WITH § 120 BENEFIT CLAIM and § 119(a)-(d) PRIORITY CLAIM TO A FOREIGN APPLICATION

Sample Application Publication – Guideline 1

United States

Patent Application Publication

**1st § 111(a)
filing date**

Appl. No.: 10/054,260

Filed:

Jan. 22, 2002

**3rd 111(a) application
filing date**

Pub. No.: US 2002/0068916 A1
Pub. Date: Jun. 6, 2002

Related U.S. Application Data

(62) Division of application No. 09/597,124, filed on Jun. 20, 2000, which is a division of application No. 09/322,532, filed on May 28, 1999, now patented.

(30) **Foreign Application Priority Data**

May 29, 1998 (JP) 10-149082
Apr. 23, 1999 (JP) 11-117139

1st foreign application filing date

If U.S. patent or application publication issued from an application under 35 USC § 111(a), and the patent or application does not claim a benefit of an IA, the patent or application publication has a § 102(e) prior art date as of the earliest U.S. effective filing date.

U.S. application publication § 102(e)(1) date: 28 May 1999

No benefit of the foreign application is given for § 102(e).

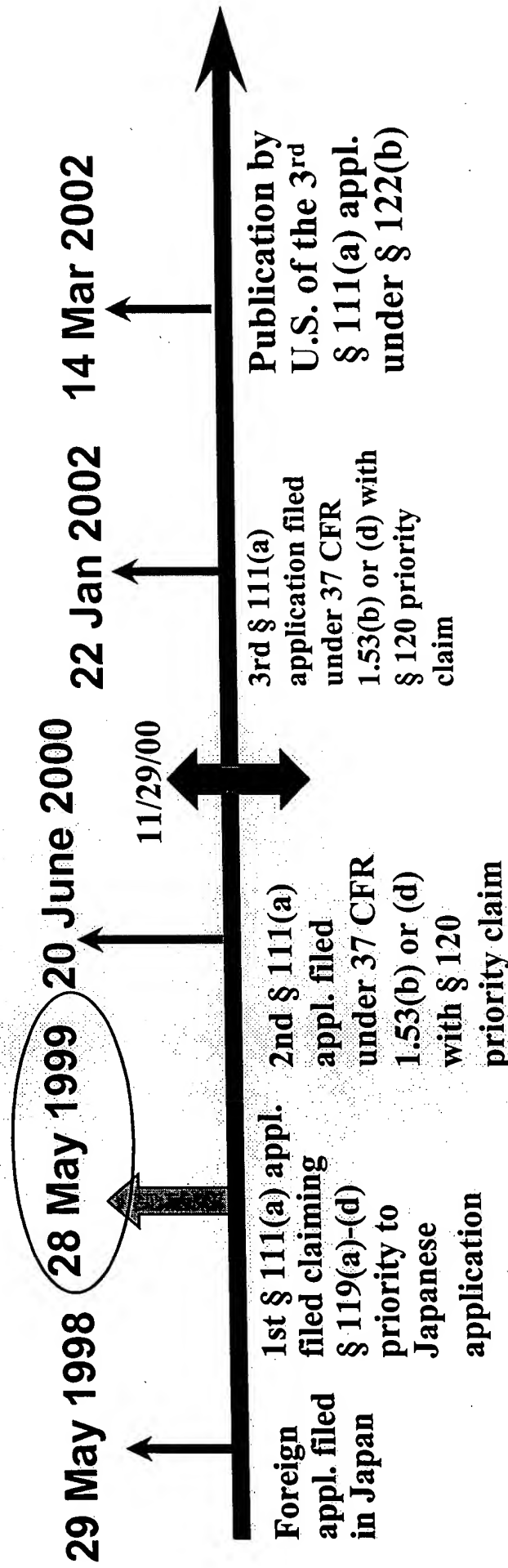
(In re Hilmer, 149 USPQ 480 (CCPA 1966)).

November 14, 2002

§ 102(e) after HR 2215

EX. A1B. PUBLICATION OF § 111(a) APPLICATION WITH § 120 BENEFIT CLAIM and § 119(a)-(d) PRIORITY CLAIM TO A FOREIGN APPLICATION

Sample Timeline – Guideline 1



U.S. application publication § 102(e)(1) date: 28 May 1999

No benefit of the foreign application is given under § 102(e)(1).
(In re Hilmer, 149 USPQ 480 (CCPA 1966)).

Ex. P1: PATENT DERIVED FROM AN APPLICATION FILED UNDER § 111(a) WITH § 119(e) or § 120 PRIORITY/BENEFIT CLAIMS

Sample Patent – Guideline 1

United States Patent

Yoshihara

Patent No.: US 6,455,204 B1

Date of Patent: Sep. 24, 2002

Filed:

Dec. 27, 2000

← Filing date of 2nd
§111(a) appl.

Related U.S. Application Data

Continuation of application No. 09/313,986, filed on May 19, 1999, now Pat. No. 6,197,457.

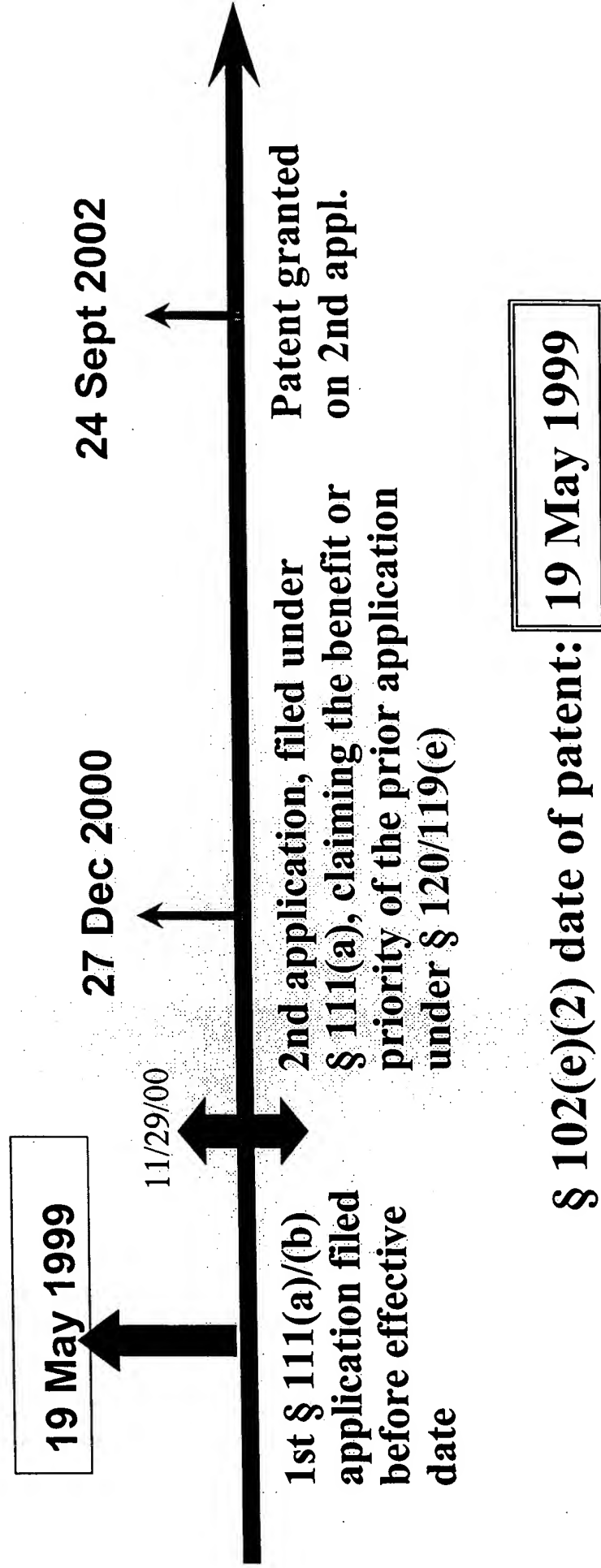
← Filing date of 1st
§111(a) appl.

If U.S. patent or application publication issued from an application under 35 USC § 111(a), and the patent or application does not claim a benefit of an IA, the patent or application publication has a § 102(e) prior art date as of the earliest U.S. effective filing date.

§ 102(e)(2) date of patent: 19 May 1999

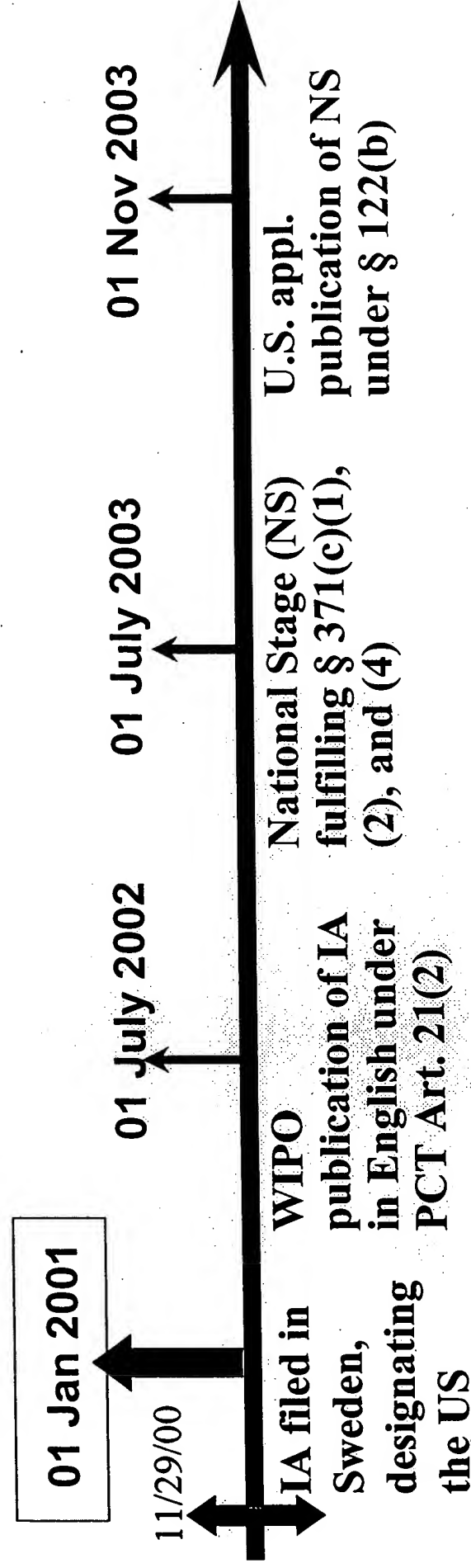
Ex. P1: PATENT DERIVED FROM AN APPLICATION FILED UNDER § 111(a) WITH § 120 OR § 119(e) PRIORITY/BENEFIT CLAIMS

Sample Timeline – Guideline 1



**Ex. A2A: PUBLICATION OF NATIONAL STAGE APPLICATION
AFTER PUBLICATION OF IA BY WIPO IN ENGLISH**

Sample Timeline – Guideline 2

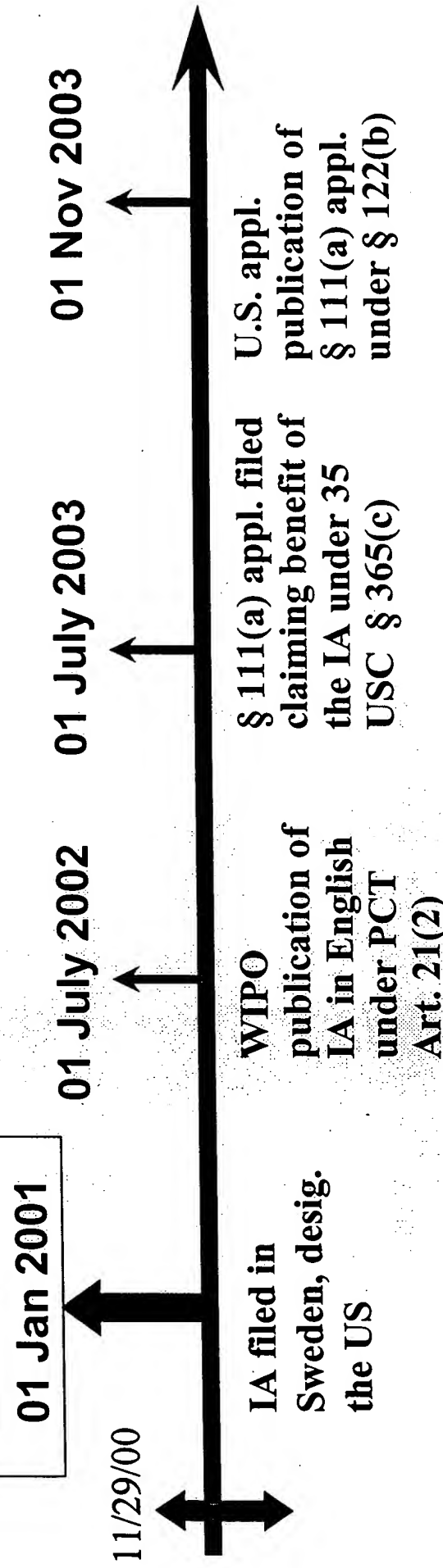


§ 102(e)(1) date of U.S. application publication P: 01 Jan 2001
§ 102(e)(1) date of WIPO publication of IA (PCT): 01 Jan 2001

– Note: subsequent National Stage entry is not required before the
 WIPO publication may be applied as prior art.

**Ex. A2B: PUBLICATION OF § 111(a) APPLICATION WHICH IS A
CONTINUATION OF AN IA FILED ON/AFTER 11/29/00 AFTER
PUBLICATION OF IA BY WIPO IN ENGLISH**

Sample Timeline – Guideline 2

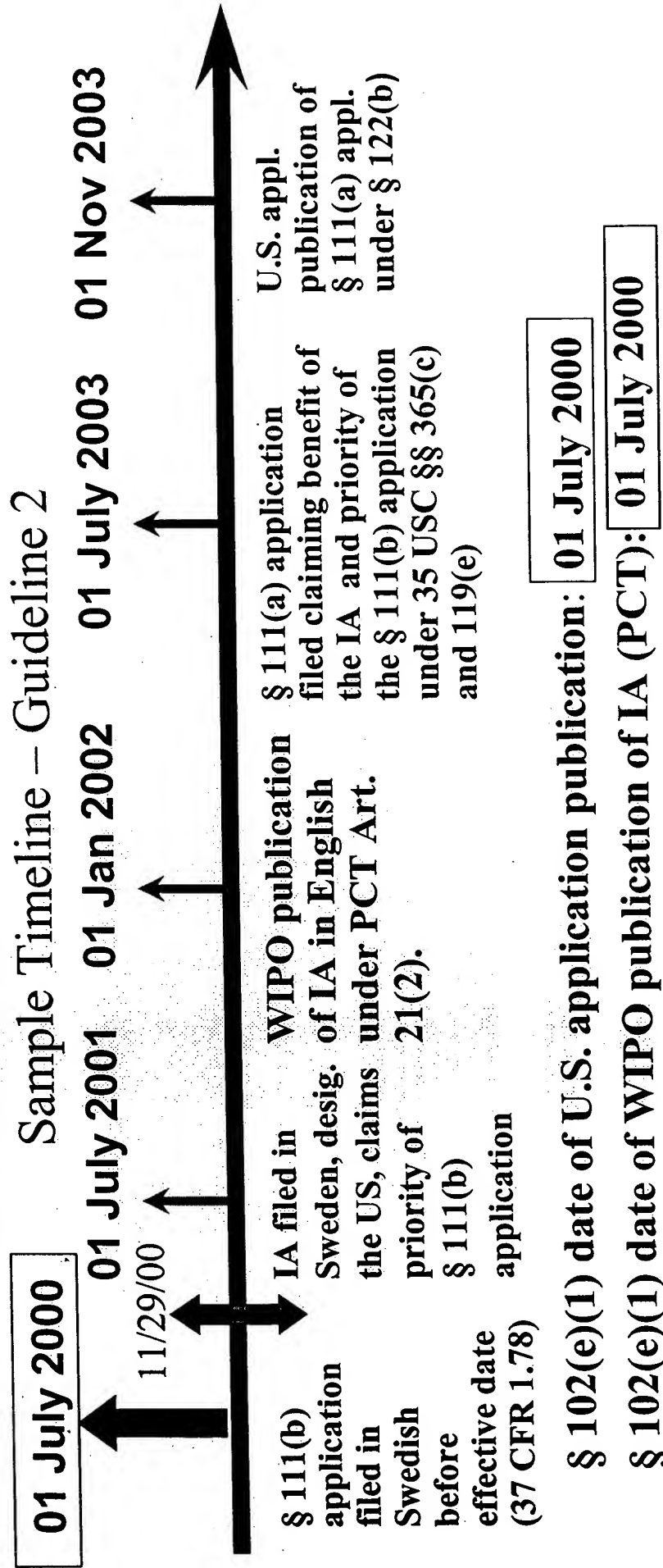


§ 102(e)(1) date of U.S. application publication: 01 Jan 2001

§ 102(e)(1) date of WIPO publication of IA (PCT): 01 Jan 2001

– note: subsequent National Stage entry is not required before the WIPO publication may be applied as prior art

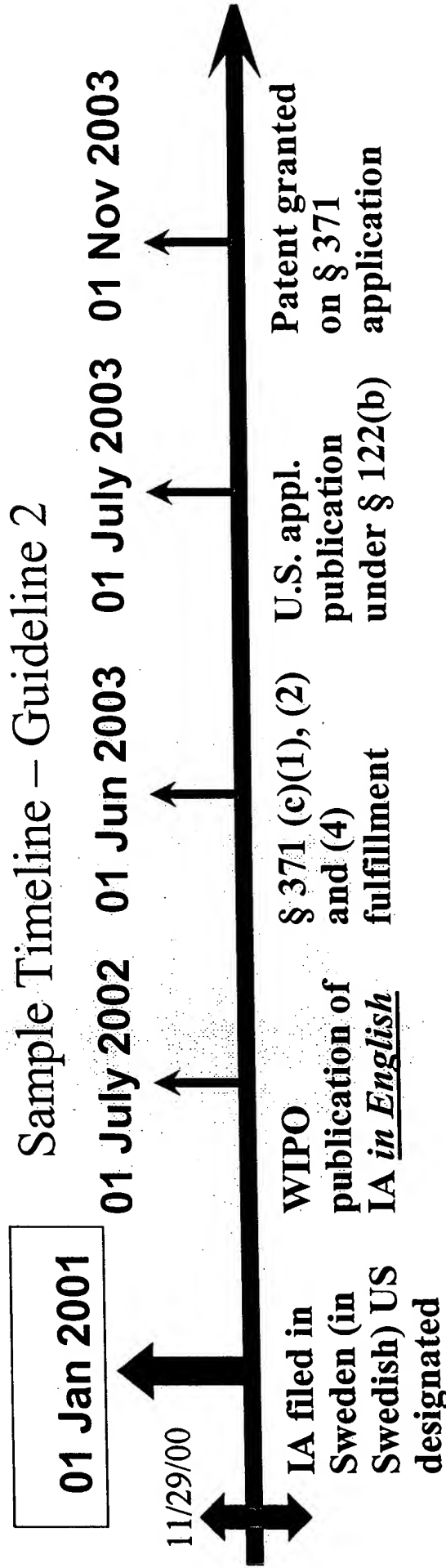
Ex. A2C: PUBLICATION OF § 111(a) APPLICATION WHICH IS A CONTINUATION OF AN IA FILED ON/AFTER 11/29/00 AFTER PUBLICATION OF IA BY WIPO IN ENGLISH WHICH CLAIMS PRIORITY TO A PRIOR U.S. § 111(b) APPLICATION



Note:

Subsequent National Stage entry is not required before the WIPO publication may be applied as prior art. A translation of the § 111(b) application is required upon notice of the Office. See 37 CFR 1.78(a)(5)(iv).

Ex. P2C: PATENT DERIVED FROM THE NATIONAL STAGE OF AN IA (§ 371 APPLICATION) FILED ON/AFTER 11/29/00



If the U.S. patent, U.S. application publication, or WIPO publication issued from, or claims benefit to, an IA which has an international filing date on or after 11/29/00, designated the United States, and was published in English under PCT Article 21(2), the § 102(e) date is the international filing date, or any earlier effective U.S. filing date.

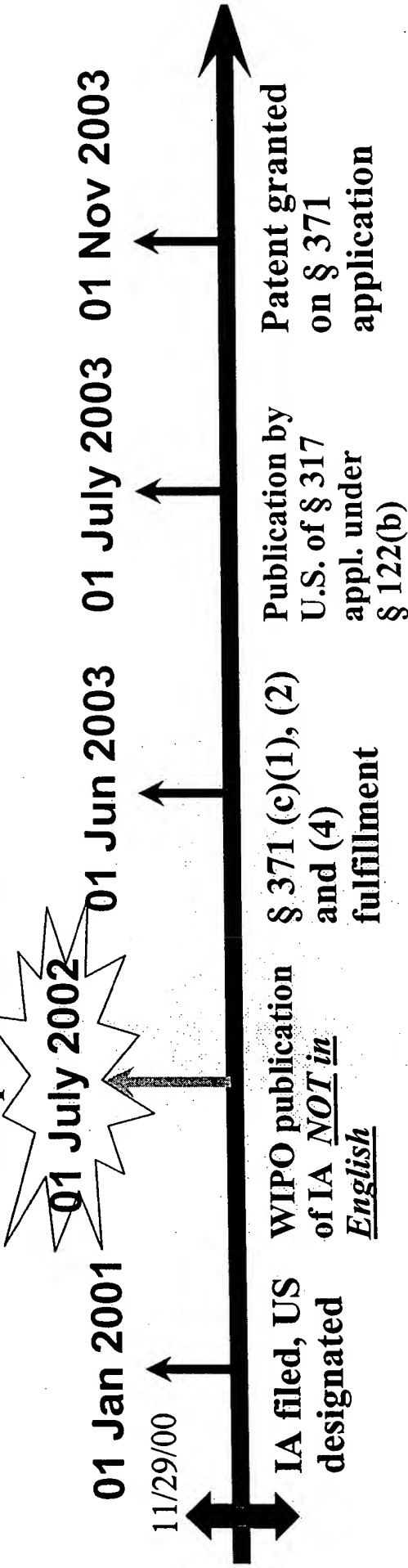
§ 102(e)(2) date of the patent: 01 Jan 2001

Notes:

- (1) § 102(e)(1) date of the WIPO publication is 01 Jan 2001
- (2) § 102(e)(1) date of U.S. application publication is 01 Jan 2001.
- (3) Prior to the AIPA, the § 102(e) date of the patent would have been 01 Jun 2003.

**Ex. P3C: PATENT DERIVED FROM THE NS OF AN IA (§ 371 APPL.)
FILED ON/AFTER 11/29/00, WIPO PUBLICATION NOT IN ENGLISH**

Sample Timeline – Guideline 3



Guideline 3. If the U.S. patent or U.S. application publication issued from, or claims benefit to, an IA which was filed on or after 11/29/00, but the WIPO publication was not in English the U.S. patent or application publication: if issued from the 35 USC § 371 application has no § 102(e) date, or if issued from a U.S. continuing application claiming benefit of the prior IA has the § 102(e) date of the filing date of a later-filed continuing U.S. application

§ 102(e)(2) date of the patent: NONE

This patent is not available as prior art under § 102(e)

Notes: (1) Publication P and the IA publication do NOT have a § 102(e)(1) date because the

IA was not published in English

(2) ~~Best prior art date~~ for the disclosure is the § 102(a) or (b) date of the WIPO publication:

~~01 July 2002~~

(3) ~~Prior to the AIPA~~, the § 102(e) date of the patent would have been 01 Jun 2003.

November 14, 2002

§ 102(e) after HR 2215

The End

For contact and web site information, see slide 38.